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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,407	08/27/2001	Hideki Noma	450108-02924	4158
20999	7590	06/29/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			THEIN, MARIA TERESA T	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/914,407		NOMA, HIDEKI	
	<b>Examiner</b>		<b>Art Unit</b>	
	Marissa Thein		3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's "Reponses Under 37 CFR § 1.111" filed on April 11, 2006 has been considered.

Claims 1-50 remain pending in this application.

### ***Information Disclosure Statement***

The Japan Application Nos. 1-1-3740 and 11-188678 were not considered because there were no English translations. In addition, Japan Application No. 11-126017 is not considered because there was no copy provided.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,750 to Barad et al. in view of PCT World Publication No. WO 99/32203 to Schorr et al.**

Regarding claims 1, 6, 11, 16, and 21, Barad discloses a system, method, device, and computer program for purchasing or receiving an order for a virtual creature (personalized toy) existing as a software and programmed to act or more, comprising: first communication means provided on the order sender side (accessing a computer in 110 is performed by customer 60) of the virtual creature (collecting orders, col. 5, lines

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50-61, Figure 5); second communication means provided on the order receiving side of the virtual creature (processing ordering, col. 5, lines 50-51; col. 6, lines 52-61, Figure 5); a communication path to connect between the first and the second communication means (Figure 5; col. 5, lines 50-57; col. 6, lines 50-59); the second communication means comprising: question data transmission means for transmitting questions data regarding changeable items in the software (select attributes to change) of the virtual creature and/or hardware holding a recording medium in which the software is stored to the first communication means that accesses via the communication path (Figure 5, col. 5, line 66- col. 6, line 15; col. 6, lines 31-39); wherein said changeable items include internal conditions, which include at least one of a emotional tendency, an instinct tendency, or an action configuration program (the toy may be programmed to say a .....move in a particular way, col. 3, lines 63-65); and data processing means for conducting the predetermined data processing in order to form the virtual creature and/or the hardware reflecting the order sender's answer to the question to be transmitted from the first communication means via the communication path (Figure 5, col. 6, lines 37-40).

However, Barad does not explicitly disclose wherein the action configuration program comprises a probability automation to determine a next action. Barad does disclose the toy can be programmed to move in a particular way (col. 3, lines 63-55).

Schorr, on the other hand, teaches wherein the action configuration program comprises a probability automation to determine a next action (page 16, line 17 – page 17, line 15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system, method, device, and computer program of Barad, to include the action configuration program comprises a probability automation to determine a next action, as taught by Schorr, in order to provide interaction between the child and the figure (virtual creature) (Schorr, page 1, line 8).

Regarding claims 2-5, 7-10, 12-15, 17-20, 22-25, 27-30, 32-35, 37-40, 42-45, and 47-50, Barad discloses the changeable item is the specification on the action or motion (programmed to move in a particular manner) of the virtual creature and robotic device (col. 3, lines 63-67); changeable items are the design of the virtual creature or the hardware and robotic device (col. 5, lines 52-65, Figure 7, Figures 13-17; Figures 21-22); the data processing means analyzes the taste and/or the living environment of the order sender based on the order sender's answer to the question and conducts the data processing according to the analysis result (Figure 5, col. 6, lines 30-40; col. 6, lines 49-59); and the data processing means forms the image data of computer graphic image of the virtual creature and robotic device (representational image showing he personalized toy) and/or the hardware reflecting the order sender's answer to the question, and transmits the image data to the first communication means via the communication path (Figure 5; col. 6, lines 60-66)

Regarding claims 26, 31, 36, 41 and 46, Barad discloses a system, method, device, and computer program for purchasing or receiving an order of a robotic device (personalized toy...may include other types of components, such as electronic components housed within the toy and programming for such electronics....toy may be

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programmed to move in a particular manner, col. 3, lines 57-67) to act or move based on the predetermined program, comprising: first communication means provided on the order sender side (accessing a computer in 110 is performed by customer 60) of the robotic device (collecting orders, col. 5, lines 50-61, Figure 5); second communication means provided on the order receiving side of the robotic device (processing ordering, col. 5, lines 50-51; col. 6, lines 52-61, Figure 5); a communication path for connecting the first and the second communication means (Figure 5; col. 5, lines 50-57; col. 6, lines 50-59); the second communication means comprising: question data transmission means for transmitting questions data on changeable items (select attributes to change) of the robotic device to the first communication means that accessed via the communication path (Figure 5, col. 5, line 66- col. 6, line 15; col. 6, lines 31-39); wherein said changeable items include internal conditions, which include at least one of a emotional tendency, an instinct tendency, or an action configuration program (the toy may be programmed to say a .....move in a particular way, col. 3, lines 63-65); and data processing means for conducting the predetermined data processing to construct the robotic device by reflecting the order sender's answer to the question to be transmitted from the first communication means via the communication path (Figure 5, col. 6, lines 37-40).

However, Barad does not explicitly disclose wherein the action configuration program comprises a probability automation to determine a next action. Barad does disclose the toy can be programmed to move in a particular way (col. 3, lines 63-55).

Schorr, on the other hand, teaches wherein the action configuration program comprises a probability automation to determine a next action (page 16, line 17 – page 17, line 15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system, method, device, and computer program of Barad, to include the action configuration program comprises a probability automation to determine a next action, as taught by Schorr, in order to provide interaction between the child and the figure (virtual creature) (Schorr, page 1, line 8).

### ***Response to Arguments***

Applicant's arguments filed April, 11, 2006 have been fully considered but they are not persuasive.

Applicant remarks that "Barad and Schorr do not teach or suggest storing a strength of each emotional tendency and storing a strength of each instinct tendency".

The Examiner notes that the combination of Barad and Schorr do teach or suggest the storing a strength of each emotional tendency and storing a strength of each instinct tendency. Barad teaches electronic components which is housed within the toy and programming for such electronics (col. 3, lines 59-60). The toy may be programmed to say a particular phrase or set of words, play a particular tune or song, or move in a particular manner (Barad, col. 3, lines 63-65). The programming is retained in the electronic component so that the information of the program is available for processing purposes. Programs can only be executed when they are in storage. The

program is held for subsequent use in a device or medium until required by the processor.

Such electronic components which is housed within the toy and programming for such electronics; the toy being program to say a particular phrase or set of words, play a particular tune or song, or move in a particular manner; and the program can only be executed when stored are considered "storing a strength of each emotional tendency and storing a strength of each instinct tendency".

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot  
June 19, 2006



**STEVE B. MCALLISTER**  
**PRIMARY EXAMINER**